

Appl. No. 10/809,356
Amendment dated: September 9, 2005
Reply to OA of: June 13, 2005

REMARKS

Applicants have amended the claims to more particularly define the invention taking into consideration the outstanding Official Action. Claim 1 has been amended to incorporate the limitations of claims 2, 6, 15 and 18 thereto. Claims 2, 6, 15 and 18 have been canceled without prejudice or disclaimer. The amendments are fully supported by the specification as originally filed which includes the original claims. Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of claims 1-5, 9, 10, and 12-20 under 35 U.S.C. 102(e) as being anticipated by Butler has been carefully considered but is most respectfully traversed in view of the amendment to claim 1 and the following comments.

Applicant wishes to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 828, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

Applicants believe that the newly amended claim 1 has novelty over the Butler reference because the originally filed claim 6, which limitation has been added to claim 1 by the present amendment, was not rejected as anticipated by this reference. Accordingly, it is most respectfully requested that this rejection be withdrawn in view of this amendment to claim 1.

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The rejection of claims 1, 6-8 and 18 under 35 U.S.C. 103(a) as unpatentable over Hayward in view of Wilson et al., and claims 11 and 15-17 over Butler has been carefully considered but is most respectfully traversed.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

Applicants believe that the presently claimed invention is non-obvious over Hayward and Wilson because the originally filed claim 2 has not been included in the 103 rejection. Since the limitation from claim 2 has been added to claim 1 by the present amendment, it is most respectfully submitted that this amendment obviates the rejection. The teachings of the secondary reference relied upon in the rejection does

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not overcome the deficiencies of the primary reference as noted above. Since the remaining claims in the rejection are either directly or indirectly dependent on amended claim 1, these claims are equally allowable and it is most respectfully that this rejection be withdrawn

Applicants also wish to point out that the Butler reference at col. 5, lines 15-20, cited by the Examiner is a commercially available graphite powder (Asbury 4172), having 99% of the particles have a particle size of 50-80 mesh. According to Butler at col. 13, lines 22-27, Asbury 4172 contains 1.38% -80 mesh and 1.45% at -200 mesh. This does not conform to the newly amended claim 1. There is no motivation in the prior art to make the necessary modifications and arrive at the presently claimed invention. Accordingly, it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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REF:kdd
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September 9, 2005